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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,753	12/17/2001	David I. Watkins	960296.95874	8557

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EXAMINER	
LI, QIAN JANICE	
ART UNIT	**PAPER NUMBER**
1632	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/869,753	WATKINS ET AL.	
	Examiner	Art Unit	
	Q. Janice Li	1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *The proposed claim amendment would raise new issues under 35 USC 1st & 2nd paragraphs.*

3. ☒ Applicant's reply has overcome the following rejection(s): The objection of the specification for sequence compliance..

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1, 4-13*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because:

Claim 1 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 and 20 of copending Application No. 09/434,830, because the proposed amendment has not been entered.

Claim 1 stands provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/434,830 because the proposed amendment has not been entered.

Claim 1 stands rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter, because the proposed amendment has not been entered.

Claims 1, and 4-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller et al (Immunol Cell Biol 1997;75:389-96) and Fuller et al (Vaccine 1997;15:924-5), in view of Hanke et al (J Gen Virol 1998 Jan;79:83-90), Borgne et al (Virol 1998;240:304-15), and further in view of Loktev et al (J Biotechnol 1996;44:129-37).
The response presented arguments discussed during the interview, that the two Fuller et al references deal with antibodies, the Loktev et al reference looks at antibody and helper T cell responses in mice, no CTL were measured, the Hanke paper used a more relevant MVA-multiepitope construct, only low levels of CTL was induced in mice, and it is surprising to see the vaccine disclosed in the Borgne paper worked in macaques, because macaques do not express mouse MHC class 1 molecules.
These arguments are addressed below.
Although Fuller and Loktev references did not measure for CTL response, it does not necessarily mean that the CTL response was not already there. An antigen could induce many different types of immune response in the host, particularly in view of the antigens and means of immunization used in these references meet claim limitation.
The Hanke paper used a construct that meet claim limitation, tested it in mice and human cells, thus, supposedly, it should have had the similar effects in mice or in human, given the comparable levels of vaccine effect in mice and macaques as taught by Borgne et al. The rejection relied on Borgne et al for comparison of vaccine effects on mouse and primates including humans, the fact that the vaccine effect on macaques in the reference is surprising to the inventor does not change the validity of the rejection.
Accordingly, the rejection stands..

JANICE LI
PATENT EXAMINER